



ORIGINAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. **1001-0700**

NCR Docket No.: **9236**

Application of: **Daniel F. White**

Group Art Unit: **3627**

Serial No.: **09/678,885**

Examiner: **Andrew J. Rudy**

Filed: **October 3, 2000**

For: **Selective Omission of Transaction Data in a Digital Receipt**

RECEIVED

NOV 22 2004

GROUP 3600

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patent, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 15, 2004

(Date of Deposit)

David M. Lockman

Name of person mailing Document or Fee

Signature of person mailing Document or Fee

November 15, 2004

Date of Signature

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks

Alexandria, VA 20231

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1, 4-6, 9 and 10 of the above-identified patent application. These claims were indicated as finally rejected in an Office Action

dated June 16, 2004. Three copies of the brief are filed herewith, together with the \$340.00 fee required under 37 CFR § 1.17(c). Also, please provide any extension of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no. 09/678,885).

(3) STATUS OF CLAIMS

Claims 1, 4-6, and 9-10 are pending in the application.

Claims 11, 14-16, 19-20 have been withdrawn from consideration.

Claims 2-3, 7-8, 12-13, and 17-18 have been canceled.

Claims 1-4, 9 and 10 are finally rejected, and are being appealed.

A listing of all claims and their status is shown in the Appendix attached to this Appeal Brief. In the final action dated June 16, 2004, the Examiner rejected claims 1, 4, and 5 under 35 U.S.C. § 112, second paragraph as being indefinite because "the party" lacked antecedent basis in the claims. Applicant submits that this minor issue will be addressed by amending the term "the party" to read

“a party” once allowable subject matter is acknowledged. The Board is respectfully requested to review these claims as if the amendment removing the ground for the section 112 rejection has been incorporated. Likewise, the same amendment will be submitted to address this minor deficiency in claim 6 once allowable subject matter is acknowledged, although the Examiner did not reject claims 6, 9, and 10 under 35 U.S.C. § 112, second paragraph even though the same use of the term “the party” is used in claim 6.

(4) STATUS OF AMENDMENTS

Appellant has filed no amendments subsequent to the Final Office Action mailed June 16, 2004.

(5) SUMMARY OF INVENTION

Appellants' invention is a retail terminal that enables a consumer to selectively remove data from a digital receipt and send it to another location for storage and later use by the consumer (Applicant's specification, page 36, line 22 to page 37, line 21). This selective modification of a digital receipt enables a consumer to address privacy concerns. The modified digital receipt that is transmitted and stored for the consumer's use is not the same digital receipt that is transmitted to a central office for processing of the transaction (Applicant's specification, page 37, lines 15-18).

(6) ISSUES

Whether claims 1, 4-6, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ganesan (U.S. Pat. No. 6,678,664).

(7) GROUPING OF CLAIMS

The rejected claims do not stand or fall together.

Claims 1 and 6 form a first separately patentable group that is argued independently of the other claims for purposes of this appeal.

Claims 4 and 9 form a second separately patentable group that is argued independently of the other claims for purposes of this appeal.

Claims 5 and 10 form a third separately patentable group that is argued independently of the other claims for purposes of this appeal.

(8) ARGUMENT

First Claim Grouping (Claims 1 and 6)

Claims 1 and 6 were rejected as being unpatentable under 35 U.S.C. § 103(a) by Ganesan (U.S. Patent No. 6,678,664). The Board of Appeals is respectfully requested to reconsider the rejection of claims 1 and 6 under 35 U.S.C. § 103(a).

Claim 1

Claim 1 reads as follows:

1. A method of processing a purchase transaction on a retail terminal, comprising the steps of:
acquiring purchase transaction data by the retail terminal as a result of the transaction performed on the retail terminal;

formatting the acquired purchase data into a digital purchase transaction record via the retail terminal;
selectively omitting purchase transaction datum from the acquired purchase transaction data in the digital purchase transaction record via the retail terminal to generate a personalized digital purchase transaction receipt; and
forwarding the personalized digital purchase transaction receipt by the retail terminal over a network that is in communication with the retail terminal to a device associated with the party selectively omitting purchase transaction datum that is identified from the acquired purchase transaction data.

Appellant's invention of claim 1 addresses the need of a consumer to have an electronic version of a digital receipt stored at a site from which the receipt may be later retrieved without certain information remaining in the receipt. To achieve this goal, the method forms a digital purchase transaction record and then enables the consumer to selectively omit purchase transaction datum from the digital purchase transaction record before forwarding the modified record to a device associated with a person who is identified in the acquired purchase transaction data.

The cited reference, U.S. Patent No. 6,678,664 to Ganesan (hereinafter "Ganesan"), expressly teaches away from such a method. Ganesan describes a method that obtains product data for a purchase transaction (Col. 17, lines 27-37), customer identification data (Col. 17, lines 38-46), and a selection of a payment type (Col. 17, lines 47-54). All three of these data are then transmitted to a central clearinghouse station over a network. The central clearinghouse then determines if the user is registered so the purchase can be approved *without the user having to provide payment information such as a credit or debit card* (Col. 17, line 59 to Col. 18, line 15). This method enables a user to buy goods and services at a location without having to carry or present payment card information. That is, the credit or debit card information is not entered at the

terminal and then selectively removed by the user for generation of a personalized purchase transaction digital receipt.

Applicant's inventive method envisions the use of credit and debit cards being presented by a user to consummate a purchase at the terminal (Applicant's specification, page 12, lines 9-15). If the user, however, wants the payment card information removed from the personalized version of the transaction record before being sent to the device associated with the user, it may be omitted before transmission. The digital purchase transaction record with the payment card information is still sent to the central office for transaction processing, but the personalized version may be modified for the user's personal records.

Ganesan is not aware of this issue and the method set forth in that reference does not address it. Instead, only one transaction record is generated and it is provided to the central clearinghouse for processing. The system of Ganesan does not generate two different records, one for transaction processing and one for the consumer's personal use. Furthermore, it does not teach or suggest the omission of acquired data from a transaction record for forwarding to a device associated with a consumer. For at least these reasons, claim 1 is allowable over Ganesan.

The Examiner notes that the Abstract of the Ganesan reference refers to the absence of payment data in a transmission for a cashless transaction. That absence, as noted above, arises from the consumer identification data being sufficient to identify a payment account and related data at the central clearinghouse. That is, the payment data is not entered and then selectively

omitted before being transmitted to the clearinghouse for transaction processing. The Ganesan reference does not remotely suggest the selective omission of acquired data for the transmission to the central clearinghouse. That suggestion would only arise from Applicant's specification, which is an impermissible use of hindsight.

The Examiner fails to set forth a *prima facie* case of obviousness because the Ganesan reference fails to suggest the selective omission of data from a transaction record generated from data acquired at a retail terminal. The Examiner attempts to buttress his position with "common knowledge" from the art. The Examiner fails to provide any basis for this common knowledge for omitting certain types of identification data to a financial institution. Without a document supporting this allegation of common knowledge, one is unable to determine when such common knowledge arose and whether it qualifies as prior art against the pending claims. Additionally, the Examiner has failed to demonstrate how this alleged common knowledge suggests the modification of the system of Ganesan so it would generate one transaction record for the central clearinghouse and another, different record for forwarding to a device associated with the user. The system of Ganesan does not acquire payment card data and it transmits all of the consumer identification data that it acquires. Therefore, the Examiner has failed to present a *prima facie* case of obviousness and the § 103(a) rejection of claim 1 must fall.

Claim 6

Because claim 6 is directed to the selective omission of transaction data from a transaction record and the forwarding of the personalized record to a device associated with the user, it is also patentable over the Ganesan reference for the reasons set forth with regard to claim 1.

Second Claim Grouping (Claims 4 and 9)

Claims 4 and 9 were rejected as being obvious under 35 U.S.C. § 103 over Ganesan. The Board of Appeals is respectfully requested to reconsider the rejection of claims 4 and 9.

Claim 4

Claim 4 depends from claim 1 and reads as follows:

4. The method of claim 1, further comprising the steps of:
identifying a device to which the personalized digital purchase transaction receipt is forwarded with data from the purchase transaction datum that corresponds to a consumer who tendered payment through the retail terminal during the purchase transaction.

Because claim 4 depends from claim 1 it is patentable for the reasons set forth above with respect to claim 1. Furthermore, it requires that the device to which the personalized digital purchase transaction receipt is forwarded be identified with data obtained from the purchase transaction datum. Ganesan fails to teach or suggest the identification of a device associated with a user or consumer. Ganesan is directed to the generation of a record for transmission to a central clearinghouse that determines whether the corresponding user has an

account that is sufficiently solvent to warrant approval of the transaction.

Therefore, Ganesan does not provide a teaching or suggestion for its modification to send a transaction record to a device associated with a consumer. Consequently, the Examiner has failed to present a *prima facie* case for obviousness.

The Examiner's reliance on the common knowledge noted above cannot sufficiently supplement the deficient evidentiary basis presented by the Examiner to save his obviousness allegation. The "common knowledge" of withholding consumer identification data from a transmission, even if it is available as prior art (and the Examiner has failed to demonstrate how it can be available), does not provide any motivation for modifying the Ganesan reference to identify a device associated with a consumer so that a personalized digital receipt may be sent to the device. The Examiner is using too many aspects of Applicant's specification to present a *prima facie* case of obviousness and this type of proof is impermissible. Therefore, claim 4 is allowable over the references of record.

Claim 9

Claim 9 also requires the identification of a device associated with a consumer from the purchase transaction data. Therefore, claim 9 is allowable over the references of record for the reasons set forth with regard to claim 4.

Third Claim Grouping (Claims 5 and 10)

Claims 5 and 10 were rejected as being obvious under 35 U.S.C. § 103(a) over Ganesan. The Board of Appeals is respectfully requested to reconsider the rejection of claims 5 and 10.

Claim 5

Claim 5 depends directly from claim 1. As a result, claim 5 is allowable for the reasons hereinbefore discussed with regard to claim 1. Moreover, claim 5 recites additional novel and nonobvious limitations. In particular, claim 5 reads as follows:

5. The method of claim 1, further comprising:

generating a human readable hard copy of the personalized digital purchase transaction receipt at the retail terminal.

Claim 5 requires that the retail terminal generate a human readable hard copy of the personalized digital purchase transaction receipt. Ganesan fails to teach or suggest the generation of a hard copy of a personalized receipt for a number of reasons. For one, Ganesan does not generate a personalized digital purchase transaction receipt by selectively omitting data from acquired purchase transaction data. For another, Ganesan only teaches the printing of the same digital bill that is processed internally by the on-site system of Ganesan (Col. 18, lines 37-41). Therefore, Ganesan does not provide a teaching or suggestion for modifying the system taught by the reference so it generates a hard copy of a digital receipt that is different from the one processed by the system for consummation of the transaction. Consequently, the Examiner has failed to present a *prima facie* case for obviousness.

The Examiner's reliance on the common knowledge noted above cannot sufficiently supplement the deficient evidentiary basis presented by the Examiner to save his obviousness allegation. The "common knowledge" of withholding consumer identification data from a transmission, even if it is available as prior art (and the Examiner has failed to demonstrate how it can be available), does not provide any motivation for modifying the Ganesan reference to generate a hard copy of a digital receipt that differs by the selective omission of certain data from the internally processed record. The Examiner is using too many aspects of Applicant's specification to present a *prima facie* case of obviousness and this type of proof is impermissible. Therefore, claim 5 is allowable over the references of record.

Claim 10

Claim 10 also requires the generation of a human readable hard copy of a digital receipt that differs from the one used to consummate the transaction. Therefore, claim 10 is allowable over the references of record for the reasons set forth with regard to claim 5.

(9) CONCLUSION

The Examiner has failed to present a prima facie case that claims 1, 4-6, 9 and 10 are obvious under 35 U.S.C. § 103(a) as being unpatentable over Ganesan Pat. No. 6,678,664. The Board of Appeals, therefore, is respectfully requested to reverse the rejection of these claims.

Respectfully submitted,



David M. Lockman

Attorney for Appellant

Registration No. 34,214

November 15, 2004

Maginot, Moore & Beck
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, Indiana 46204-5130
Telephone (317) 638-2922
Facsimile (317) 638 2139

(10) APPENDIX

1. A method of processing a purchase transaction on a retail terminal, comprising the steps of:

acquiring purchase transaction data by the retail terminal as a result of the purchase transaction performed on the retail terminal;

formatting the acquired purchase transaction data into a digital purchase transaction record via the retail terminal;

selectively omitting purchase transaction datum from the acquired purchase transaction data in the digital purchase transaction record via the retail terminal to generate a personalized digital purchase transaction receipt; and

forwarding the personalized digital purchase transaction receipt by the retail terminal over a network that is in communication with the retail terminal to a device associated with the party selectively omitting purchase transaction datum that is identified from the acquired purchase transaction data.

Claims 2 and 3 (Canceled).

4. The method of claim 1, further comprising the step of:

identifying a device to which the personalized digital purchase transaction receipt is forwarded with data from the purchase transaction datum that corresponds to a consumer who tendered payment through the retail terminal during the purchase transaction.

5. The method of claim 1, further comprising the step of:
generating a human readable hard copy of the personalized digital purchase transaction receipt at the retail terminal.

6. A method of processing a purchase transaction on a retail terminal, comprising the steps of:
acquiring purchase transaction data by the retail terminal as a result of the purchase transaction performed on the retail terminal;
selecting via the retail terminal certain purchase transaction datum of the acquired purchase transaction data to generate a modified purchase transaction record;
formatting the modified purchase transaction record into a digital transaction receipt via the retail terminal; and
transmitting over a network that is coupled to the retail terminal the digital transaction receipt to a device associated with the party using the retail terminal to select purchase transaction data from the acquired purchase transaction data for the generation of the digital transaction receipt.

Claims 7 and 8 (Cancelled)

9. The method of claim 6 further comprising:
identifying the device to which the digital transaction receipt is transmitted with data from the purchase transaction data that corresponds to a consumer

who tendered payment through the retail terminal during the purchase transaction.

10. The method of claim 6, further comprising the step of:
generating a human readable hard copy of the digital transaction receipt with the retail terminal.

11. (Withdrawn) A system for processing a purchase transaction, comprising:

- a retail terminal in communication with a network;
- a processing unit within the retail terminal; and
- memory within the retail terminal and in communication with said processing unit, said memory storing a plurality of program instructions which, when executed by said processing unit, causes said processing unit to:
 - a) acquire purchase transaction data on said retail terminal during the purchase transaction;
 - b) format the acquired purchase transaction data into a digital purchase transaction record;
 - c) permit omission of selective purchase transaction datum of the acquired purchase transaction data from the digital purchase transaction record by a party to the purchase transaction to create a personalized digital purchase transaction receipt; and
 - d) transmit the personalized digital purchase transaction receipt over the network to the party to the purchase transaction.

Claims 12 and 13 (Cancelled).

14. (Withdrawn) The system of claim 11, wherein the party to the purchase transaction is a consumer who tendered payment during the purchase transaction.

15. (Withdrawn) The system of claim 11, wherein the memory has further program instructions stored therein which, when executed by the processing unit, causes the processing unit to provide a human readable hard copy of the personalized digital purchase transaction receipt to the party to the purchase transaction.

16. (Withdrawn) A system for processing a purchase transaction comprising:

- a retail terminal in communication with a network;
- a processing unit within said retail terminal; and
- memory within said retail terminal and in communication with said processing unit, said memory storing a plurality of program instructions which, when executed by said processing unit, causes said processing unit to:
 - a) acquire purchase transaction data on said retail terminal in response to the purchase transaction;
 - b) permit a party to the purchase transaction to omit certain purchase transaction datum of the acquired purchase transaction data to create a modified purchase transaction record;
 - c) format the modified purchase transaction record into a digital purchase transaction receipt; and
 - d) transmit the digital purchase transaction receipt over the network to the party to the purchase transaction.

Claims 17 and 18 (Cancelled).

19. (Withdrawn) The system of claim 16, wherein the party to the purchase transaction is a consumer who tendered payment during the purchase transaction.

20. (Withdrawn) The system of claim 16, wherein the memory has further program instructions stored therein which, when executed by the processing unit, causes the processing unit to provide a human readable hard copy of the digital purchase transaction receipt to the party to the purchase transaction.